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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/128,721	08/04/1998	TODD ROBERT CARROLL	11632N.020880	3309

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EXAMINER	
GUARRIELLO, JOHN J	
ART UNIT	PAPER NUMBER
1771	27

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-27

Office Action Summary

Application No.	Applicant(s)
09/128721	Carroll
Examiner	**Group Art Unit**
John Gravini/lo	1771

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☑ Responsive to communication(s) filed on 7/2, 26/2002, 8/14/2002, 9/9/2002, 10/21/2002.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-31, 33, 34, 43-58 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-31, 33, 34, 43-58 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

15. The Examiner acknowledges papers # 21-26, the revocation of attorney, and new power of attorney papers of 7/2/2002 and 7/26/2002; the Examiner Interview summary of 8/14/2002; the RCE papers of 9/9/2002; the amendment of 9/9/2002; and the supplemental amendment of 10/21/2002.

16. The Examiner notes the cancellation of claims 35-42 by paper of 10/21/2002.

Claim Rejections - 35 USC § 112

17. Claims 1-3, 6-19, 22-34, 45-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is still not clear what the components of the specific coating composition comprises which meet the characteristics of puncture resistance and flex crack resistance as stated in the claim. Claims merely setting forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics, are invalid as

vague, indefinite, and functional, since they cover any conceivable combination of ingredients either presently existing, or which might be discovered in the future and which would impart the desired characteristics, see Ex parte SLOB (Bd Pat App&Int) 157 USPQ 172. The term "TPO" is not clear since this appears to be the genus of the claimed invention which is a thermoplastic polyolefin elastomer which is a species of **TPO**.

In claim 13, it is not clear for the same reasons given for claim 1.

In claim 30, it is not clear for the same reasons given for claim 1.

In claim 45, it is not clear for the same reasons given for claim 1.

Applicant's arguments regarding breadth and functionality have been considered but they are not persuasive, see the cite to Ex parte SLOB. Moreover, there is no structure or chemistry to meet the properties or characteristics which applicant desires.

In claim 49, it is not clear what "TPO" encompasses as noted in claim 1, the species should be claimed not the genus which this term implies.

Claim Rejections - 35 USC § 102

18. Claims 1-3, 6-19, 22-34, 43-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Langley 5,948,708.

Rejection is maintained substantially as in paper # 17 of 11/20/2001, paper # 20 of 6/4,2002, with the modification as applied to new claims submitted in paper # 26 of 10/21/2002. Applicant's arguments regarding thermoplastic polyolefin have been considered but they are not persuasive because Langley describes polyethylene, low density polyethylene and polypropylene, column 4, lines 4-11 which are thermoplastic polyolefin, TPO. It is the Examiner's position that TPO is a genus and applicant's claimed invention is directed to a thermoplastic polyolefin elastomer which is a species of TPO, thus the species should be claimed. Furthermore, since there is no structure or chemistry in the claimed invention to meet the claimed properties applicant desires as a species of TPO and which applicant argues, the arguments are not commensurate in scope to the claims of the claimed invention. Claims still lack novelty.

19. Claims 1-31, 33, 34, 43-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Hauer et al. 5,626,947.

Rejection is maintained substantially as in paper # 17 of 11/20/2001; paper # 20 of 6/4/2002, with the modification noted to new claims submitted in paper # 26 of 10/21/2002. Applicant's arguments regarding the motivation have been considered but they are not persuasive because the present rejection is anticipation. Applicant's arguments regarding thermoplastic resin have been considered but are not persuasive because Hauer describes thermoplastic resin, see abstract; column 4, line 4-49; column 5, lines 40-50; and column 6, lines 24-60. Applicant's arguments regarding insufficient disclosure by Hauer is noted but the Examiner disagrees because applicant's claims are broader, namely directed to the genus of TPO and not the species of TPO, i.e., thermoplastic polyolefin elastomer, than Hauer describes and as noted above in this paragraph Hauer describes specific thermoplastic polyolefins. Furthermore, applicant's arguments regarding TPO are noted but TPO is a genus not TPOE, thermoplastic polyolefin elastomer, a species as described

above in this paragraph. Applicant's specification, page 7 as filed does refer to TPO as a genus but not as a species of thermoplastic polyolefin elastomer. Applicant's arguments are not commensurate in scope to the claims in the claimed invention. Applicant is arguing elastomer with TPO as a species and the claims are directed to TPO as a genus. Claims lack novelty.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

John J. Guarriello:gj

Patent Examiner

November 20, 2002

ELIZABETH M. COLE
PRIMARY EXAMINER